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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,264	03/28/2001	Satoru Ueda	450100-03087	2071

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EXAMINER	
GRAYSAY, TAMARA L	

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/819,264	UEDA, SATORU	
	Examiner	Art Unit	
	Tamara L. Graysay	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 28 March 2001 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 30 March 2000. It is noted, however, that applicant has not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Applicant has listed four Japanese Unexamined Patent Application Nos. Hei 8-163538, 9-171504, 9-175504, and 10-93950.

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- 11e (P.15, L.7)

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any

required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The abstract of the disclosure is objected to because the use of the terms "means" should be avoided. Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following informalities:

a. The acronym GUI should be spelled out at least at its first occurrence (P.13, L.14).

b. The monetary values (P.10) may be converted from yen to include US dollars.

c. In accordance with MPEP § 608.01(o), a term used in the claims may be given a special meaning in the description; however, no term may be given a meaning repugnant to the usual meaning of the term. In the present application, the use of the term "poller" is repugnant to the usual meaning of the term. The term "poller" is generally synonymous with a pollster or polltaker and used to describe one who polls; for example, see patents US-6662208 (poller polls database), US-6678703 (poller polls viewer), US-6714553 (poller polls circuit), and US-6779022 (poller polls sources). Whereas the term "pollee" is used to describe one who is asked questions in a poll; for example see patents US-4451700 (pollee response), US-5473691 (pollee stalls poller and transmits response), and US-5621894 (pollee stalls poller and transmits response). The term "pollee" should be substituted for the term "poller."

Appropriate correction is required.

Claim Rejections - 35 USC § 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, lines 6-9, the clause "contents introduction information storage means that stores the content introduction information for introducing said picture content to said poller," is repeated at lines 9-11.

Regarding claim 1, the clause beginning at line 19, "poll result counting means for discriminately counting said contents polling information stored in said contents polling information storage means between said contents polling information entered by predetermined said poller and said contents polling information entered by general said poller and for displaying the business profitability to be obtained when said content is commercialized on said display apparatus" is confusing. First, the poll result counting means (11e) is claimed as performing the functions of counting and displaying, yet the claim also recites a display means at line 4 and at the last line. It is unclear whether the counting means (11e) performs both functions, or whether there are separate counting means and display means. Second, the counting function to be performed by the poll result counting means is claimed as counting information stored in [element 11d] *between* said contents polling information entered by predetermined said poller and contents polling information entered by general said poller. It is unclear what is meant by "counting ... between." Third, it is unclear what is meant by the terms "predetermined said poller" and "general said poller" as set forth in the claim. Claims 9-11 contain the same clause and are unclear for the same reasons.

Regarding claim 7, the "poll result counting means generates" has been interpreted as an additional function, i.e., for generating, of the poll result counting means insofar as the poll result counting means was previously recited in claim 1 in means plus function format.

Regarding claim 8, line 4, "said merchandise" lacks clear antecedent basis in the claim. The phrase has been interpreted as the picture content, as recited in antecedent in claim 1.

Regarding claim 10, the preamble recites a method for ...; however, the body of the claim does not include any steps or acts using the suffix "-ing" (storing, sending, receiving, counting, determining). The claim has been treated as including method steps or acts.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-4, 7-9, and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by DeRafael (US-6529878).

Regarding claim 1, DeRafael discloses a system and apparatus comprising contents market research apparatus (Fig.2) having content storage means (20,24), sending means (18, namely the input/output circuitry's output), receiving means (18, namely the input/output circuitry's input), polling storage means (24,40), counting means for counting and for displaying (DeRafael discloses that the computer transmits user response information including statistical information, which inherently includes a counting means, C.3, L.28-44); and contents polling

apparatus (Fig.2) having receiving means (26), display means (28), polling means for entering information (32), and sending means for sending information (32,30,20). The particular item (a picture content), as broadly defined in the claim, is met by the advertisements disclosed in DeRafael.

Regarding claim 2, the advertiser's advertisement (interactive advertisement Fig.1) includes part of a picture, as broadly recited (DeRafael discloses that "part of a picture" or even a whole picture is viewed on the user's computer screen).

Regarding claim 3, DeRafael discloses that the information is classified subject-wise insofar as the computer provides a directory or keyword to find information related to a particular subject (C.2, L.60-64).

Regarding claim 4, the polling information of DeRafael includes the user's personal information (C.2, L.45-54).

Regarding claim 7, DeRafael, as described in regard to system claim 1 above, includes all of the structural limitations that are positively recited in the apparatus of claim 11. The system determines business profitability, as broadly recited, insofar as it generates statistical data (C.3, L.34-37) and the data serves as an aid to advertisers in making business decisions.

Regarding claim 8, the content polling information includes selection of an advertisement by the poller (user)

Regarding claim 9, DeRafael, as described in regard to system claim 1 above, includes all of the structural limitations that are positively recited in apparatus claim 9.

Regarding claim 11, DeRafael, as described in regard to system claim 1 above, includes all of the structural limitations that are positively recited in the computer-readable medium of

claim 11. The computer-readable medium determines business profitability, as broadly recited, insofar as it generates statistical data (C.3, L.34-37) and the data serves as an aid to advertisers in making business decisions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeRafael (US-6529878) in view of Video Week (article, Video Notes).

Video Week teaches a market research system which includes intent-to-buy as a consideration for taking a direct-to-sellthrough release of a film on video.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the research system of DeRafael to include intent-to-buy as part of a marketing research poll, such as taught by Video Week, in order to make a determination of whether a direct-to-sellthrough approach is appropriate for a picture or film that is to be released.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeRafael (US-6529878) in view of Chisholm (US-5400248).

Chisholm teaches a polling system that includes weighted votes. The vote administrator determines the weight of each vote in order to increase the importance or power of some voters over others.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the research system of DeRafael to include more ballots to one voter than to another voter, such as suggested by the weighted voting system of Chisholm, in order to increase the importance and power of the polled person who has more than one ballot. One incentive for using a weighted voting system, whereby a particular person who is polled has more ballots, is to increase the power of that person.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over DeRafael (US-6529878).

DeRafael discloses storing content information (computer database 20 stores advertisements at 24), sending stored information (output of input/output circuitry 18, sends the information), receiving polling information (input of input/output circuitry 18, receives user responses), storing polling information (computer database 20 stores the responses), and counting polling information (the computer transmits user response information including statistical information, which is inherently includes a counting step, C.3, L.28-44). DeRafael lacks the step of determining the business profitability. It is disclosed in DeRafael that the computer transmits user response information including statistical information (C.3, L.28-44). This step of transmitting the response information to the advertiser is "useful to advertisers because it aids them in targeting their advertisements and responding to consumer preferences." These disclosed benefits are evidence that the advertisers will use the information provided to them to make business decisions. The examiner takes official notice that it is well known in the business field to determine profitability of a particular endeavor when making a business decision. In order to minimize losses or maximize profits, a business decision is made based on

skill in the art to modify the disclosed method of DeRafael to include a step of determining the business profitability when an advertised product is commercialized in order to minimize losses or maximize profits.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Lerner (US-5526257) teaches a polling system having a product or information classification system.
- Boe (US-6236975) teaches a targeted marketing system and method that includes a survey respondent's personal information and matches the respondent to a product based on survey responses.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is (703) 305-1918. The examiner can normally be reached on Mon - Thu and alternate Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tlg 12/7/04

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